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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,779	12/14/2001	Scott R. Swix	01377	9532
38516 7590 11/25/2009 AT&T Legal Department - SZ Attn: Patent Docketing Room 2A-207 One AT&T Way Bedminster, NJ 07921				
EXAMINER				
VAN BRAMER, JOHN W				
ART UNIT		PAPER NUMBER		
3622				
MAIL DATE		DELIVERY MODE		
11/25/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly amended independent claims 1 and 17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The originally submitted claims were directed towards receiving programming content delivered as a scheduled lineup having advertisements inserted into future time slots. The advertisements are categorized as overridable or nonoverrideable by the network provider server. Then the network provider server receives a request from an advertiser to replace the advertisement with a different advertisement. The network provider server determines if the advertisement is overrideable, if the two advertisements are nearly equal in time length, if the two advertisements are in a compatible format, when the last time the replacement advertisement or a similar advertisement has been shown, and based upon the outcome of the determining step inserting or declining insertion of the replacement advertisement. Then the programming content including the replacement advertisement is broadcast, assuming replacement was indicated by the determining steps. The original invention acted based upon information received, there were no indications regarding the ability of the invention to actively solicit information from the advertisers. The newly proposed invention discloses a webpage that is stored at the network provider server. The webpage is to be distributed to advertisers. The network provider server also stores an advertising schedule for schedule programming and advertisement characteristics for advertisement time slots in the schedule programming. The database also stores advertisement pricing information for each

advertisement time slot. The network provider server sends the webpage to the advertiser. This newly claimed webpage notifies the advertiser of a future advertisement time slot. The advertiser then sends advertisements to the network server. The advertisements are categorized as overridable or non-overridable by the advertiser. The advertisement is then stored in memory and the database is used to select and schedule an advertisement for insertion into a future time slot. The network server then apparently receives the web page that was provided to the advertiser, the webpage now includes a request to override the schedule advertisement for the future advertisement timeslot. The network server determines if the advertisement is overrideable, if the two advertisements are nearly equal in time length, if the two advertisements are in a compatible format, when the last time the replacement advertisement or a similar advertisement has been shown, and based upon the outcome of the determining step inserting or declining insertion of the replacement advertisement. Then the programming content including the replacement advertisement is broadcast, assuming replacement was indicated by the determining steps. The originally filed claims represent a subcombination of the newly proposed combination claims. The original invention has the network provider server categorizing advertisements as overrideable or nonoverridable, and then performing steps to determine whether insertion should take place, based upon a request from the advertiser. The newly proposed claims actively solicit the receipt of information from advertiser using a web page that is sent to advertisers and allow both the network provider and the advertiser to categorize advertisements as overrideable or non-

overridable. The network server is utilized to create and store a webpage that is sent to elicit request from advertisements via a specific means of actively soliciting the advertisements. This webpage is returned with a request to replace an advertisement as well as a specification of a financial premium for replacing the advertisement. The original invention used a scheduled lineup having advertisements inserted into the future time slot. The newly proposed invention includes not only a schedule lineup having advertisement inserted into the future time slot, but also incorporates storing an advertising schedule for scheduled programming, wherein the schedule contains advertisement characteristics for each advertisement time slot in the scheduled programming, receiving advertisements from advertisers and selecting advertisements for insertion. Now we have two different types of content that is ready to be delivered. The original programming content, that is found in the original invention as well as the newly claimed invention, and was received intact and already contains advertisements. The newly proposed invention also has a second type of content that is ready for delivery; the actively solicited advertisements that it selects and inserts into a content stream. Then decisions are made as to whether to replace either the originally inserted advertisements or the newly inserted advertisement with a different advertisement. As the original invention only contemplated replacing advertisements, that have already been inserted into future time slots, and did not contemplate a specific means of actively soliciting the advertisements from an advertiser in the specified manner or the ability to actually insert said advertisements into said future timeslots, the inventions are a combination subcombination of each other. The examiner suggests that the applicants

revisit both the originally filed claims as well as the claims that were prosecuted in Office Action dated August 7, 2008, when considering future amendments.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-6, 8, and 17-20, withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Conclusion***

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN VAN BRAMER whose telephone number is (571)272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Van Bramer  
/John Van Bramer/  
Examiner, Art Unit 3622

## Notice of Non-Compliant Amendment (37 CFR 1.121)

Application No.

10/020,779

Examiner

JOHN VAN BRAMER

Applicant(s)

SWIX ET AL.

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 10 July 2009 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
  - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
  - ☐ C. Other \_\_\_\_\_.
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims).
  - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☒ E. Other: The newly amended claims are directed towards an invention that is restricted by original presentation and as such are withdrawn from consideration. Since there are, therefore, no claims currently pending the amendment is considered non-compliant. See attached.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):  
\_\_\_\_\_

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

### TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

- Abandonment** of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or
- Non-entry** of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

/John Van Bramer/ Examiner, Art Unit 3622	
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**Notice of Non-Compliant Amendment (37 CFR 1.121)**



